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EXAMINER

STEVENS, ROBERT

ART UNIT PAPER NUMBER

2176

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,914

Applicant(s)

BROMAN ET AL.

Examiner

Robert M Stevens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-21 are pending in Application No. 09/895,914, entitled "Automated Document Formatting Tool", filed 6/29/2001. Claims 1, 2, 4, 8, 10, 13, 15, 17 and 21 are independent.
2. No Information Disclosure Statement has been filed as of the date of this communication.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: Fig. 1 (#151 and 152).
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "139" and "206" have both been used to designate Formatting Rules.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "138" and "204" have both been used to designate Formatting Component.

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6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "408" and "418" in Fig. 4, reference characters "920" and "948" in Fig. 9, reference characters "1022" and "1038" in Fig. 10, and reference characters "1122" and "1134" in Fig. 11 have been used to designate exiting from the routine diagrammed in the respective figures. A potential reason for multiple exit points may be to handle error conditions, in which case they should be labeled to indicate different functionality.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "A" and "B" have both been used to designate input/output paths in Figures 7 and 9.

8. The drawings are objected to as failing to comply with 37 CFR §84(q) because Figures 3-12 are missing lead lines.

9. The drawings are objected to because many of the text descriptions extend past the boundaries of the containing flow chart symbol. For example, refer to Fig. 5 #510 and the text of the decision/diamond flow chart symbol.

10. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the

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sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

11. The disclosure is objected to because of the following informalities:
 - a. Page 3 line 15: "paragraphmarker" should be "paragraph marker".
There are numerous other instances where words or words and reference numerals are mistakenly concatenated;
 - b. Page 12 line 16: "he" should be "the"; Please resolve all spelling/grammatical/etc. issues throughout the specification. And,
 - c. Page 23 lines 17-25 indicate that an Option Manager Dialog Box is updated with invalid names (please explain).

Appropriate correction is required.

12. The attempt to incorporate subject matter into this application by reference to the US Patent Application mentioned on p. 39 lines 2-7 is improper because there is insufficient identifying indicia that would minimize the public's (and the

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Office's) burden to search for and obtain copies of that application. If an application number is unknown, the customary identification indicia is the title, inventor name(s) and filing date. Note that the Office could not readily identify the referenced application.

Additionally, Applicant is reminded of MPEP 608.01(p) guidance to direct particular attention to "specific portions of the referenced document where the subject matter being incorporated may be found."

13. Note that the application (09/620,876) incorporated by reference at page 14 lines 15-20 has issued as US Patent No. 6,583,798. Please update the specification accordingly.

Additionally, Applicant is reminded of MPEP 608.01(p) guidance to direct particular attention to "specific portions of the referenced document where the subject matter being incorporated may be found."

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. **Claims 1-21 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

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Regarding independent claims 1, 2, 4, 8, 10, 13, 15, 17 and 21: The language of these claims raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101.

For example, a claim is not considered to be in the technological arts if the claim language is such that the claim elements could be performed using pencil or paper (or paper, scissors and tape).

Regarding claims 3, 5-7, 9, 11-12, 14, 16 and 18-20, these claims are dependent upon the above referenced independent claims, as appropriate, and therefore are likewise rejected.

Claim Rejections - 35 USC § 112

16. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. **Claims 4-7 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the enablement requirement. These claims contain subject matter

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which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding independent method claim 4, there was no enablement as to:

adding a second paragraph mark to the document element, in response to a determination that the entire paragraph has been selected and that the first paragraph mark has not been included in the document element

There was no implementation detail provided in the specification regarding this limitation.

Claims 5-7 are dependent upon claim 4, and therefore are likewise rejected.

Additionally regarding claim 7, there is a lack of enablement within the specification as to:

wherein the determination of whether the selection action indicates a desire to select the entire paragraph comprises determining whether the selection cursor has been moved in a leftward direction.

There was no implementation detail provided in the specification regarding this limitation.

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18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. **Claims 4-9 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent method claim 4, the claim is vague/indefinite as to the eliminating of a first paragraph mark in a selected document element, which does not contain a paragraph mark.

Claims 5-7 are dependent upon claim 4 and therefore likewise rejected.

Additionally, regarding claim 7, there is a lack of antecedent basis for "the selection cursor" of line 3.

Regarding independent method claim 8, the claim is vague/indefinite as to a second paragraph in a targeted document, which does not contain a reference to a first paragraph.

Claim 9 is dependent upon claim 8 and therefore likewise rejected.

Additionally, the last limitation of claim 9 merely re-iterates the last limitation of claim 8, causing the scope of this claim to be vague/indefinite.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. **Claims 1-3 and 10-20 are rejected under 35 U.S.C. 102(b)** as being anticipated by Microsoft Word (version 6.0) User's Guide, published by Microsoft Corporation, Document No. WB57923-0394, (c) 1994, pp. 36-45, 60-61, 65, 125-128, 150-152, 154, 167-170, 180-181, 189-191, 283-290, and 302 (hereafter referred to as "WUG94").

Regarding independent system claim 1, WUG94 discloses:

A system for formatting a document, comprising:
a source document having at least one document element;
(P. 44, Figure at top of page showing "Cut or Copy" document [source] and shaded/selected document element)
a target document; (P. 44, Figure at top of page showing the "Paste" document [target])
a formatting component operative to copy the document element from the source document and to paste the document

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element into the target document; (P. 44, Figures at top of page show a copy from the source to a paste into the target document, with a formatting component being inherent in the design of the prior art word processor) and

a formatting rules component (p. 40, first two sentences under "Be Careful ... [Paragraph] Mark"), discussing a paragraph mark) containing at least one formatting rule (p. 40, 2nd sentence under "Be Careful ... Mark", discussing that the "mark stores the formatting for the text and graphics in that paragraph"), an associated formatting action (p. 127, figure in middle of page shows paragraph and font formatting), and an associated recovery action; (p. 40, 2nd sentence under "Be Careful ... Mark", discussing that the use of the undo button to recover from a previous edit)

wherein the formatting component formats the document element accordance with the formatting action, in response to a determination that the formatting rule has been triggered; (p. 127, figure in middle of page shows paragraph and font formatting), and an associated recovery action; (p. 40, 2nd sentence under "Be Careful ... Mark", discussing that the use of the undo button to recover from a previous edit) and

wherein the formatting component performs the recovery action, in response to receiving a recovery selection. (p. 40 "To Undo ... Changes", 1st bullet "To undo ... most recent action, click the undo ... button")

Regarding independent method claim 2, WUG94 discloses:

A method for formatting a document element, the method comprising:

determining the selection of the document element in a source document; (p. 42 under "2. Do one of ...", second bullet describes the selection of a copy element)

determining whether a first formatting rule applies to the selection of the document element; (p. 45, 1st paragraph under heading "Copying and Pasting ...?")

formatting the document element in response to a determination that the first formatting rule applies to the selection of the document element; (p. 45, 2nd paragraph under "Copying and Pasting ...?", last sentence states: "the formatting in the section break is applied ...")

determining the selection of a paste point; (p. 42, # 3. states "position the insertion point in the new location")

determining whether a second formatting rule applies to the selection of the paste point; (p. 45, 3rd paragraph under "Copying and Pasting ...?", especially the second bullet in that paragraph)
formatting the document element in response to a determination that the second formatting rule applies to the selection of the document element; (p. 45, last paragraph stating that "the text takes on the ... formatting of the document it is pasted into") and
pasting the document element into a target document. (p. 42 # 4. [in middle of page])

Regarding claim 3, which is dependent upon claim 2, WUG94 discloses:

further comprising the steps of:
displaying an available recovery action; (p. 40, figure at top of page)
determining whether the available recovery action has been selected; (p. 40, figure at top of page, especially the caption "click or drag to select ...") and
re-formatting the document element in accordance with the recovery action, in response to the determination that the recovery action has been selected. (p. 40, 1st bullet under heading "To undo ... changes ...")

Regarding independent method claim 10, WUG94 discloses:

A method for defining a formatting style in a target document, the method comprising the steps of:

determining the selection of the document element in the source, document, the document element having an associated formatting style; (p. 44, top series of figures, esp. "Cut or Copy")
determining a paste point in a target document, the target document having a corresponding formatting style; (p. 41, paste point shown at cursor position in middle figure)
receiving an instruction to paste the document element in the target document at the paste point; (p. 41, 3rd figure shows result of a paste operation when mouse button is released)
determining whether the corresponding formatting style and the associated formatting style are identical; p. 40, bottom left figure

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showing two paragraphs where formats are determined [i.e., they're not the same format, and are therefore displayed differently])

determining whether the corresponding formatting style has been used or redefined in the target document; (p. 168, 1st sentence [active document analyzed and applies a style/format])

defining the corresponding formatting style to be identical to the associated formatting style, in response to a determination that the corresponding formatting style and the associated formatting style are not identical and that the corresponding formatting style has been used or redefined in the target document. (p. 40 bottom right figure, in which corresponding and associated styles are set to the formatting of the second paragraph)

Regarding claim 11, which is dependent upon claim 10, WUG94

discloses:

further comprising the steps of:

pasting the document element in the target document at the paste point; (p. 44, top series of figures showing "Cut or Copy" and "paste")

applying the associated style to the pasted document element; (p. 180, "**Applying Styles to Text**", esp. 1st sentence "use the following techniques to apply styles ...") *and*

renaming the associated style, in response to a determination that the corresponding formatting style has been used or redefined in the target document and that the corresponding formatting style and the associated formatting style are not identical. (p. 189, 1st sentence under "Creating New Styles")

Regarding claim 12, which is dependent upon claim 10, WUG94

discloses:

further comprising the steps of:

determining whether the corresponding formatting style belongs to a formatting style group; (p. 168, 1st sentence)

determining whether member formatting style in the formatting style group has been used or redefined in the target

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document; p. 169, #2 under "To format text automatically", esp. "word analyzes the text and applies styles from the attached template")

applying the associated style to the pasted document element; and renaming the associated style, in response to a determination that the in the formatting style group has been used or member formatting style redefined in the target document and that the corresponding formatting style and the associated formatting style are not identical. (p. 169, #3 under "To format text automatically ...")

Regarding independent method claim 13, WUG94 discloses:

A method for eliminating empty paragraphs from a document, the method comprising the steps of:

determining the selection of a document element in a source document; (p. 44, top left figure, in which shaded area represents document element selection)

determining a first number of preceding empty paragraphs adjacent to the document element; (p. 60, "Finding and Replacing Special Characters", especially 2nd bullet "paragraph marks")

determining a first number of following empty paragraphs adjacent to the document element; (p. 60, "Finding and Replacing Special Characters", especially 2nd bullet "paragraph marks")

determining a total of the first number of preceding empty paragraphs and the first number of preceding empty paragraphs; (p. 60, "Finding and Replacing Special Characters", especially 2nd bullet "paragraph marks")

eliminating the following empty paragraphs from the source document, in response to a determination that the total is less than a first predetermined threshold value. (p. 170, last paragraph discussing "Word indicates the extra paragraph marks it ... deleted")

⁰
Regarding claim 14, which is dependent upon claim 13, WUG94

discloses:

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further comprising the steps of:

determining a paste point in a target document; (p. 44, top left figure, in which shaded area represents document element selection)

determining a second number of preceding empty paragraphs adjacent to the paste point; (p. 60, "Finding and Replacing Special Characters", especially 2nd bullet "paragraph marks")

determining a second number of following empty paragraphs adjacent to the paste point; (p. 60, "Finding and Replacing Special Characters", especially 2nd bullet "paragraph marks")

determining a total of the second number of preceding empty paragraphs and the second number of preceding empty paragraphs; (p. 60, "Finding and Replacing Special Characters", especially 2nd bullet "paragraph marks")

eliminating at least one following empty paragraphs from the target document, in response to a determination that the total is less than a second predetermined threshold value. (p. 170, last paragraph discussing "Word indicates the extra paragraph marks it ... deleted")

Regarding independent method claim 15, WUG94 discloses:

A method for merging and creating a list, the method comprising:

determining the selection of a document element in a source document; (p. 37, left margin figure)

determining a paste point in a target document; (p. 41, middle figure referring to an "insertion point")

determining whether the document element is a first list item; (p. 151, right-most figure under "Sorting a List" shows the element "vanilla" as a first list item))

determining whether the paste point is adjacent to a second list item in a first list in the target document; (p. 153, "Note" found at the bottom of the page, esp. "Word displays a 6 when you press ENTER after the fifth item" [in other words, Word determines list item numbers])

pasting the document element as a third list item in the first list, in response to a determination that the document element is the first list item and that the paste point is adjacent to the second list item in the first list in the target document. (p. 154, 1st paragraph, especially if "you add, delete or reorder items in a numbered list, word updates the numbering for you.")

Regarding claim 16, which is dependent upon claim 15, WUG94

discloses:

further comprising the following steps:

displaying a recovery action user interface; (p. 40, figure at top of page) and

removing the third list item from the first list (p. 154, 1st paragraph, esp. "the cut command") and pasting the document element as a first item in a second list (p. 154, 1st paragraph, esp. drag-and-drop editing to "move items between lists"), in response to receiving a recovery action selection. (p. 154, 1st paragraph, esp. "you can correct the formatting easily")

Regarding independent method claim 17, WUG94 discloses:

A method for formatting a table in a target document, the method comprising the steps of:

determining the selection of a document element in a source document; (p. 37, left margin figure)

determining whether the document element is a first table item; (p. 284, 1st paragraph "dotted gridlines" indicates that Word recognizes element as a table)

determining a paste point in a target document; (p. 41, middle figure referring to an "insertion point")

determining whether the paste point is adjacent to a first table in the target document; (p. 290, right-most figure in middle of page showing paste point of first row of table)

merging the document element with the first table, in response to a determination that the document element is the first table item and that the paste point is adjacent to the first table in the target document. (p. 290, figures in middle of page show cut/paste of selected row)

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Regarding claim 18, which is dependent upon claim 17, WUG94

discloses:

further comprising the steps of:

*displaying a recovery action user interface; (p. 40, figure at top of page) and
removing the document element from the first table and
pasting the document element as an independent table in the target document, in response to receiving a recovery action selection. (p. 280, figures in middle of page show pasting with tables as a move operation)*

Regarding claim 19, which is dependent upon claim 17, WUG94

discloses:

further comprising the steps of:

determining whether the paste point is within the first table in the target document; (p. 290, right-most figure in middle of page showing paste point of first row of table)

pasting the document element into the first table as a nested table, in response to a determination that the document element is the first table item and that the paste point is within the first table in the target document. (p. 283, "Filling in Text and Graphics", especially 2nd paragraph "you can paste a graphic in any cell of the table")

Regarding claim 20, which is dependent upon claim 17, WUG94

discloses:

further comprising the steps of:

determining whether the document element is a single table cell; (p. 287, 1st sentence "Before you insert a new cell")

pasting the document element into the target document as a non-table text item, in response to a determination that the document element is the single table cell. (p. 284, paragraph following "Converting Text to or from a Table", discussing conversion of a table to ordinary text paragraphs))

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. **Claims 4-9 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Microsoft Word (version 6.0) User's Guide, published by Microsoft Corporation, Document No. WB57923-0394, (c) 1994, pp. 36-45, 60-61, 65, 125-128, 150-152, 154, 167-170, 180-181, 189-191, 283-290, and 302 (hereafter referred to as "WUG94") in view of Luebbert (US Patent No. US 5,530,794, issued Jun. 25, 1996, hereafter referred to as "Luebbert").

Regarding independent method claim 4, WUG94 discloses:

A method for adding and eliminating a paragraph mark from a document element selected from a paragraph in a source document, the method comprising:

determining the selection of the document element; (p. 44, "Cut or Copy" figure at top of page, showing selection in black)

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determining the portion of the paragraph represented by the document element; (p. 44, "Cut or Copy" figure at top of page, showing document element in black)

determining whether a first paragraph mark is included in the document element; (p. 40, bottom, left margin figure illustrating the "Show/Hide ¶" button to display whether a paragraph mark is in a document element)

determining whether a selection action indicates a desire to select the entire paragraph; (p. 126, last paragraph, especially "when moving or copying ... to keep the paragraph's formatting")

adding a second paragraph mark to the document element, in response to a determination that the entire paragraph has been selected and that the first paragraph mark has not been included in the document element; (p. 127, top figure in left margin discussing use of undo function to add a second paragraph mark)

WUG94, however, does not explicitly disclose:

eliminating the first paragraph mark from the document element, in response to a determination that the entire paragraph has been selected and that the selection action does not indicate a desire to select the entire paragraph.

Luebbert, though, discloses:

eliminating the first paragraph mark from the document element, in response to a determination that the entire paragraph has been selected and that the selection action does not indicate a desire to select the entire paragraph. (col. 13 lines 46-54, discussing the elimination of the "single 10 character" paragraph mark or delimiter)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Luebbert for the benefit of WUG94, because to do so would allow a programmer to track the appropriate paragraph delimiter used and to translate any foreign delimiter to the native delimiter as taught by Luebbert in the last two sentences of the Abstract.

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It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Luebbert for the benefit WUG94 because these references were all applicable to the same field of endeavor, i.e., the editing of electronic documents.

Regarding claim 5, which is dependent upon claim 4, the limitations of claim 4 have been previously discussed.

WUG94 further discloses:

wherein the selection of the document element includes an instruction to copy the document element. (p. 41, under the heading "To copy text ...", especially # "2. In Windows ...")

Regarding claim 6, which is dependent upon claim 4, the limitations of claim 4 have been previously discussed.

WUG94 further discloses:

wherein the selection of the document element includes an instruction to cut the document element. (p. 41, under the heading "To move text ...", especially # "2. In Windows ...")

Regarding claim 7, which is dependent upon claim 4, the limitations of claim 4 have been previously discussed.

WUG94 further discloses:

wherein the determination of whether the selection action indicates a desire to select the entire paragraph comprises determining whether the selection cursor has been moved in a

*leftward direction. (p. 36, figure under the heading “**Selecting Text and Graphics Using the Mouse**”, especially the caption “the area immediately to the left of text is selection bar”)*

Regarding independent method claim 8, WUG94 discloses:

A method for eliminating a paragraph mark from a document element selected from a source document, the method comprising:

determining the selection of the document element in the source document; (p. 42 under “2. Do one of ...”, second bullet describes the selection of a copy element)

determining a paste point in a target document; (p. 42, # 3. states “position the insertion point in the new location”)

determining whether a first paragraph mark is included in the document element; (p. 125, bottom two figures show determination that a first paragraph mark [after “Orchestra”] is included in the selected text)

determining whether the paste point is within a second paragraph in the target document; (p. 40, bottom, left margin figure illustrating the “Show/Hide ¶” button to display whether a paragraph mark is in a document element) and

WUG94, however, does not explicitly disclose:

eliminating the first paragraph mark from the document element, in response to a determination that the paste point is within the second paragraph in the target document and that the first paragraph mark is included in the document element.

Luebbert, though, discloses:

eliminating the first paragraph mark from the document element, in response to a determination that the paste point is within the second paragraph in the target document and that the first paragraph mark is included in the document element. (col. 13 lines 46-54, discussing the elimination of the “single 10 character” paragraph mark or delimiter)

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It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Luebbert for the benefit of WUG94, because to do so would allow a programmer to track the appropriate paragraph delimiter used and to translate any foreign delimiter to the native delimiter as taught by Luebbert in the last two sentences of the Abstract.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Luebbert for the benefit WUG94 because these references were all applicable to the same field of endeavor, i.e., the editing of electronic documents.

Regarding claim 9, which is dependent upon claim 8, the limitations of claim 8 have been previously discussed.

WUG94 further discloses:

further comprising the steps of:

determining whether the document element is a list item; (p. 150, "Modifying Bullets or Numbers" in which a list is selected/determined)

determining whether the paste point is within a list in the target document; (p. 150, "Modifying Bullets or Numbers" in which a list is selected/determined)

However, WUG94 does not explicitly disclose:

eliminating the first paragraph mark from the document element, in response to a determination that the paste point is within the list in the target document, that the first paragraph mark is included in the document element, and that the document element is not a list item.

Luebbert, though, discloses:

eliminating the first paragraph mark from the document element, in response to a determination that the paste point is within the list in the target document, that the first paragraph mark is included in the document element, and that the document element is not a list item. (col. 13 lines 46-54, discussing the elimination of the "single 10 character" paragraph mark or delimiter)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Luebbert for the benefit of WUG94, because to do so would allow a programmer to track the appropriate paragraph delimiter used and to translate any foreign delimiter to the native delimiter as taught by Luebbert in the last two sentences of the Abstract.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Luebbert for the benefit WUG94 because these references were all applicable to the same field of endeavor, i.e., the editing of electronic documents.

24. **Claim 21 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Greg Harvey et al., Microsoft Office 2000: 9 in 1 for Dummies, published by Wiley Publishing, ISBN: 0-7645-0333-2, (c) 1999, pp. 245-254 (hereafter referred to as "Harvey") in view of Microsoft Word (version 6.0) User's Guide, published by Microsoft Corporation, Document No. WB57923-0394, (c) 1994, pp. 36-45, 60-61, 65, 125-128, 150-152, 154, 167-170, 180-181, 189-191, 283-290, and 302 (hereafter referred to as "WUG94").

Regarding independent method claim 21, Harvey discloses:

A method for pasting spreadsheet elements, the method comprising:
determining the selection of a spreadsheet element having a
first set of formatting properties in a source document; (p. 254
"Copying or Moving by Dragging", #1 Select cell or range)
determining a paste point in a target document; (p. 254
"Copying or Moving by Dragging", #4 Drag mouse to new
location)
pasting the spreadsheet element as a table in the target
document with the first set of formatting properties applied thereto;
(p. 254 "Copying or Moving by Dragging", #5 Release mouse
button)

Harvey, however, does not explicitly disclose:

displaying a recovery action user interface;

WUG94, though, discloses:

displaying a recovery action user interface; (p. 40, figure at
top of page)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of WUG94 for the benefit of Harvey, because to do so would enable a user to undo multiple actions as taught by WUG94 in the second bullet under the p. 40 heading **"To undo or redo changes in text or graphics"**.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of WUG94 for the benefit Harvey because these references were all applicable to the same field of endeavor, i.e., the editing of electronic documents.

Furthermore, Harvey does not explicitly disclose:

removing the table from the target document and pasting the spreadsheet element as a table in the target document with a second set of formatting properties applied thereto.

WUG94, though, also discloses:

*removing the table from the target document and pasting the spreadsheet element as a table in the target document with a second set of formatting properties applied thereto. (p. 302, 1st sentence under “**Exchanging Data with Microsoft Excel**”, discussing pasting an Excel Worksheet into a Word document)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of WUG94 for the benefit of Harvey, because to do so would allow a user to work with Word commands manipulate spreadsheet data as taught by WUG94 on p. 302, 2nd sentence under “**Exchanging Data with Microsoft Excel**”, discussing the use of Word commands to work with spreadsheet data.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of WUG94 for the benefit Harvey because these references were all applicable to the same field of endeavor, i.e., the editing of electronic documents.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M Stevens whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 7:00 - 3:30. After mid-October 2004, the Examiner can be reached at (571) 272-4102.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Stevens
Art Unit 2176
Date: August 12, 2004

rms


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